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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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08/994,831

12/19/1997

ILEANA A. LEUCA

CASE13-8

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02/08/2005

PERKINS COIE LLP/AWS

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EXAMINER

JAGANNATHAN, MELANIE

ART UNIT

PAPER NUMBER

2666

DATE MAILED: 02/08/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

08/994,831

Applicant(s)

LEUCA ET AL.

Examiner

Melanie Jagannathan

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2666

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 June 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2-5, 7, 8, 13-18, 20-25 and 27-31 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 2-5, 7, 8, 13-18, 20-25 and 27-31 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 2-5, 7-8, 13-15, 17-18, 20-25, 27-31 are rejected under 35 U.S.C. 102(e) as being anticipated by Csapo US 5,910,946.

Regarding claims 2, 22, 25, the claimed system for managing routing of information from source to destination through a plurality of networks, with at least one of the networks is a packet network is disclosed by routing of telephone calls with devices coupled to PSTN (Figure 3, element 32) and performing Internet calls with devices coupled to communication network (element 31). See column 3, lines 17-46. The claim comprising routing processor for receiving a query signal from source via a wireless link is disclosed by mobile subscriber initiates call by dialing a destination number which is captured by internet base station (Figure 5, step 501). See column 4, lines 11-13. The claimed query specifies the destination to which information will be routed and processor is configured to identify a subscriber service associated with destination is disclosed by control unit of base station accesses home location register to request identification of called party number (step 502) and if information can be found in HLR, the called party is reachable via Internet connection (step 508). See column 4, lines 14-39. The claimed memory

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for storing one or more characteristics of destination is disclosed by base station utilizing a home location register to request identification of called party number.

The claimed processor determines route for transmission of information based on query signal, based on identified subscriber service associated with destination and based on characteristics in memory, wherein one of the one or more characteristics of destination includes information relating to equipment at destination and processor or network element other than source packetizes information sent over route is disclosed by base station retrieving information on called party number from HLR, determines internet based voice call as subscriber service is possible and base station transmits packetized compressed speech to called party's address (step 510). See column 4, lines 31-39.

Regarding claims 3-4, 23-24, the claimed source subscribes to fixed wireless service network is disclosed by user can be mobile subscriber (Figure 3, element 30).

Regarding claim 5, the claimed destination subscribes to PSTN network is disclosed by possibility of mobile-to-land line equipment directed call. See column 4, lines 18-30, column 5, lines 33-37.

Regarding claims 7-8, 27-28, the claimed digitized voice and DTMF signal is disclosed by compression of speech from PCM to packet form. See 3, lines 47-67, column 4, lines 1-7.

Regarding claims 13-15, 21, 29-31, the claimed method for managing routing of information from source to destination through a plurality of networks, with at least one of the networks is a packet network and wherein each network is linked to atleast one other network by a communication medium is disclosed by voice communication via interconnection of PSTN, Internet for telephones and mobile subscribers (Figure 3). The claimed query specifies the

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destination to which information will be routed and processor is configured to identify a subscriber service associated with destination is disclosed by control unit of base station accesses home location register to request identification of called party number (step 502) and if information can be found in HLR, the called party is reachable via Internet connection (step 508). See column 4, lines 14-39. The claimed memory for storing one or more characteristics of source and destination is disclosed by base station utilizing a home location register to request identification of called party number.

The claimed determining route for transmission of information based on query signal, based on identified subscriber service associated with destination and based on characteristics in memory, wherein one of the one or more characteristics of destination includes information relating to equipment at destination and processor or network element other than source packetizes information sent over route is disclosed by base station retrieving information on called party number from HLR, determines internet based voice call as subscriber service is possible and base station transmits packetized compressed speech to called party's address (step 510). See column 4, lines 31-39.

Regarding claim 17-18, the claimed equipment at destination comprising computer or modem is disclosed by modems (Figure 1, elements 12) and computers (elements 11).

Regarding claim 20, the claimed destination subscribes to wired network and equipment is configured to accept information via wired network alone and path does not comprise a packet network in addition to wired network is disclosed by when mobile-to-land line equipment directed call where internet base station connects call request to local exchange via ISDN connection (Figure 5, element 505).

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Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

4. Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Csapo US 5,910,946 in view of Maroulis et al. US 6,584,094

Csapo discloses equipment being mobile phones, telephones, computers and modems. Csapo does not disclose destination equipment being a facsimile device. Maroulis et al. discloses telephonic communications over Internet where endpoints could be facsimile devices. See column 12, lines 54-67, column 2, lines 45-67. At the time the invention was made it would have been obvious to a person of ordinary skill in the art to have destination be a fax. One of ordinary skill in the art would be motivated to do this in order to have the ease of sending faxes to a destination.

Response to Argument

5. Applicant's arguments filed 6/23/2003 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Kimball US 5,953,322 discloses cellular Internet telephone.

Narayanaswamy US 6,295,457 discloses integrated cellular telephone base station with Internet gateway.

Xu et al. US 6,151,628 disclose direct wireless to network access.

Shtivelman et al. US 6,078,581 disclose Internet call waiting.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

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however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Melanie Jagannathan whose telephone number is 571-272-3163. The examiner can normally be reached Monday-Friday 8:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Seema S. Rao can be reached on 571-272-3174. The fax phone number for the organization where this application or proceeding is assigned is 571-273-3174.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Melanie Jagannathan
Patent Examiner
AU 2666


FRANK DUONG
PRIMARY EXAMINER

MJ

